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| 10/622,145      | 07/18/2003  | Felix L. Sorkin      | 1101-161            | 1891             |

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09/20/2004

EXAMINER

BRINSON, PATRICK F

| ART UNIT | PAPER NUMBER |
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3752

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/622,145

Applicant(s)

SORKIN, FELIX L.

Examiner

Patrick F. Brinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/27/03
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Double Patenting*

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101, which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1, 4-10, 13 and 18-20 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 4-13 of prior U.S. Patent No. 6,666,233. This is a double patenting rejection.

The '233 patent to **Sorkin** recites in claims 1 and 9, a tubular body having a longitudinal axis, said tubular body having a plurality of corrugations extending radially outwardly therefrom, each of said plurality of corrugations being in spaced relation to an adjacent corrugation, the tubular body having an interior passageway suitable for receiving cables therein, each of the plurality of corrugations opening to said interior passageway, the tubular body having a first longitudinal channel extending between pairs of said plurality of corrugations on one side of said tubular body and a pair (at least one) longitudinal channel extending between adjacent pairs of said plurality of corrugations on an opposite side of said tubular body, as recited in claim 1 of the application. Claims 4-8 of '233 recite the subject matter recited in claims 4-8 of the application. Likewise, claims 10 and 11 of '233 recite the subject matter recited in claims 9 and 10 of the application. Claim

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12 of '233 recites subject matter recited in claims 13, 18 and 19 of the application, while claim 13 of the '233 reference recite subject matter of claim 20 of the application.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 11 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 6,666,233 in view of US 3,605,817 to **Bauman et al.** The '233 reference discloses the recited subject matter with the exception of the plurality of corrugations extending radially outwardly from the tubular wall. The patent to **Bauman et al.** '233 discloses flexible tubing having corrugations and longitudinal grooves (13') that extend along the length of the tube. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the '233 tubing to include corrugations, as suggested by **Bauman et al.** in order to provide increased flexibility of the tubing.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-10, 13-15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by US 3,605,817 to **Bauman et al.**

The patent to **Bauman et al.** discloses a flexible corrugated tubing having a longitudinal axis, said tubular body having a plurality of corrugations extending radially outwardly therefrom, each of said plurality of corrugations being in spaced relation to an adjacent corrugation, the tubular body having an interior passageway suitable for receiving cables therein, each of the plurality of corrugations opening to said interior passageway, the tubular body having a first longitudinal channel extending between pairs of said plurality of corrugations on one side of said tubular body and a second longitudinal channel extending between adjacent pairs of said plurality of corrugations on an opposite side of said tubular body, as recited in claim 1. The channels are diametrically opposed to each other, as recited in claim 2, and fig. 3 discloses the first and second channels extending outwardly of the tubular body a distance less than a distance that the plurality of corrugations extend from the body, as recited in claim 3.

6. Claims 1, 2, 4, 5, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,944,059 to **Masui**.

The patent to **Masui** discloses a tubular body having a longitudinal axis, said tubular body having a plurality of corrugations (2) extending radially outwardly therefrom, each of said plurality of corrugations being in spaced relation to an adjacent corrugation, the tubular body having an interior passageway suitable for receiving cables therein, each of the plurality of

corrugations opening to said interior passageway. The tubular body having a first longitudinal channel (K) extending between pairs of said plurality of corrugations on one side of said tubular body and a second longitudinal channel extending between adjacent pairs of said plurality of corrugations on an opposite side of said tubular body, as recited in claim 1. The first and second channels are diametrically opposed to each other, as recited in claim 2, and extend along the entire length of the tubular body, being open at opposite ends of the tubular body, as recited in claims 4 and 5.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Bauman et al.** in view of **Masui**.

The patent to **Bauman et al.** discloses all of the recited subject matter with the exception of the longitudinal channels opening at opposite ends of the tubular body. The patent to **Masui** discloses corrugated tubing with a channel extending the length of the tube running between and through the corrugations. **Masui** discloses that it is old and known in the art to provide longitudinal channels between adjacent corrugations and to have the channel open at the opposite ends. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the body of **Bauman et al.** to

have the longitudinal channels open at opposite ends as suggested by **Mausi** in order to allow for flow there through or to easily insert material within the channels.

8. Claims 11, 12, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bauman et al.** in view of 5,720,139 to **Sorkin**.

The patent to **Bauman et al.** discloses the tubular body, as discussed in preceding paragraph # 5, however, it does not disclose a tendon extending through the passageway or a grout material filling the interior of the body. The patent to **Sorkin '139** discloses a tubular body (50) having at least one tendon (52) extending within the passageway. Col. 5, lines 27-30, discloses that grout is pumped into the interior of the duct (50) until voids in the duct are filled with grout. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide to the tube of **Bauman et al.**, a tendon and grout material, as suggested by **Sorkin** in order to produce a post tensioning system.

#### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Dal Palu e'aciu Attilio, Pfleger '864 and '532, Sorkin '135, DeGain, Kleykamp, Kant and Medford et al. are pertinent to Applicant's invention in disclosing corrugated pipes. The patent to Sorkin '300 is pertinent in disclosing a tendon-receiving duct.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Patrick F. Brinson** whose telephone number is (703) 308-0111. The examiner can normally be reached on M-F 7:30-3:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Michael Y. Mar** can be reached on (703) 308-2087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick F. Brinson  
Primary Examiner  
Art Unit 3752

P. F. Brinson  
September 16, 2004